

REMARKS

Reconsideration of the pending application is respectfully requested on the basis of the following particulars:

Rejection of claims 1 and 8 under 35 U.S.C. § 103(a)

Claims 1 and 8 presently stand rejected as unpatentable over Kaneko (U.S. 4,241,899) in view of Grote et al (U.S. 6,546,596). This rejection is respectfully traversed for the following reasons.

Applicant has amended claim 1 to more particularly define the invention taking into consideration the outstanding Official Action. Claim 1 is amended to more fully describe the relationship between the tubular jack handle and the movable bar, wherein the movable bar is movable against a bias, by the insertion of the jack handle, to a position clear of the jack handle, and wherein the movable bar is resiliently driven back into engagement with the locking groove of the jack handle. It can be recognized that this unique arrangement allows the jack handle to be inserted and locked into place in the insertion hole by the movable bar without requiring that a user manually manipulate the movable bar. In other words, the jack handle may be readily and easily “snapped” into place, and subsequently removed by pulling on the movable bar to allow the jack handle to be removed from the insertion hole.

To establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations.

It is respectfully submitted that neither Kaneko nor Grote, nor any combination thereof, teaches or suggests all the claim limitations of claim 1. To establish prima facie obviousness of a claimed invention, *all the claim limitations* must be taught or suggested

by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974). "***All words in a claim*** must be considered in judging the patentability of that claim against the prior art." *In re Wilson*, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970) (emphasis added).

Kaneko discloses a jack having a handle that is retained in a socket by a bolt that is inserted through the wall of the socket for engagement with an end of the handle. However, Kaneko fails to disclose or suggest that the bolt is, or may be replaced by, a movable bar, wherein the movable bar is movable against a bias, by the insertion of the jack handle, to a position clear of the jack handle, and wherein the movable bar is resiliently driven back into engagement with the locking groove of the jack handle. Instead of the quick assembly, or "snap lock" functionality of the present invention according to claim 1, the Kaneko device simply employs a bolt for fixing the jack handle in place. The bolt will require the use of a wrench, or other tool, to assemble and disassemble the jack handle, in contrast to the "snap lock" assembly of the present invention.

Grote discloses an extension pole that comprises a tubular handle portion and a tubular extension that telescopes within the tubular handle portion. A spring biased pin assembly is disposed on the tubular handle portion, and comprises a pin that may be engaged with any of a plurality of apertures formed along the length of the tubular extension. The length of the extension pole is set by telescoping the tubular extension within the tubular handle to the desired length, aligning one of the apertures with the pin assembly, and inserting the pin into the aperture.

Grote, however, does not disclose or suggest that the pin is movable by insertion of the tubular extension to a position clear of the tubular extension, and subsequently resiliently driven back into engagement with a locking groove. In fact, Grote does not employ a locking groove. Instead, Grote employs the plurality of apertures formed along the length of the tubular extension for the lengthwise adjustment of the extension pole.

The Grote apparatus is concerned with the lengthwise adjustment of an extension pole, but is not concerned with the quick assembly and disassembly of the extension pole.

There is no teaching or suggestion that the Grote apparatus has, or may be modified to have, the quick assembly, or “snap lock” functionality of the present invention. On the contrary, the Grote device is configured so that the tubular extension cannot be removed from the tubular handle. As clearly stated in the Grote specification (at column 8, lines 22-27), “while the extension tube 16 is free to slide axially within the outer handle 12 to any position desired once the lock pin 42 has been pulled to disengage the pin 42 from any of the locking holes 48, the extension tube 16 *cannot extend in any case* beyond the point where the stop pin 56 engages with the alignment tab.” (emphasis added).

Another significant difference between the Grote patent and the present invention is that the Grote device is expressly configured to *prevent* the tubular extension from rotating within, and with respect to, the tubular handle, while the present invention is configured, by the use of the locking groove, to *allow* the rotation of the jack handle within the insertion hole.

The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, not in applicant's disclosure. In *re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). It is respectfully submitted that no such teaching or suggestion is found in either the Grote or the Kaneko patents. Instead, it appears that Grote teaches away from a combination of a spring biased pin that engages with locking groove (extending circumferentially about the jack handle) because of the express concerns stated in Grote about preventing the axial rotation of the tubular extension within the tubular handle. Further, Grote teaches away from a configuration that allows the quick removal an insertion of an inner tube into an outer tube, because Grote expressly states that the tubular extension *cannot in any case* be removed from the tubular handle.

Kaneko requires that the jack handle be free to rotate within the socket, because the rotation of the jack handle is required for the operation of Kaneko's jack. Therefore, it the teachings of Grote that stress that the tubular extension is not allowed to rotate within the tubular handle achieve a goal counter to a requirement of Kaneko. It follows that there can be no suggestion or motivation to modify Kaneko according to the teachings of Grote,

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because elimination of the rotation of Kaneko's handle would render the Kaneko jack non-functional.

It is respectfully submitted that, for at least these reasons, the amended claim 1 is allowable over the references cited of record. Because claims 2-8 depend from claim 1, it is respectfully submitted that claims 2-8 are also allowable, for the same reasons. Regarding claim 6, while claim 6 is presently withdrawn, it is respectfully submitted that, because claim 1 is allowable, and claim 1 appears to be generic over all of the dependent claims, claim 6 is presently allowable. Withdrawal of the rejection is respectfully requested.

#### Conclusion

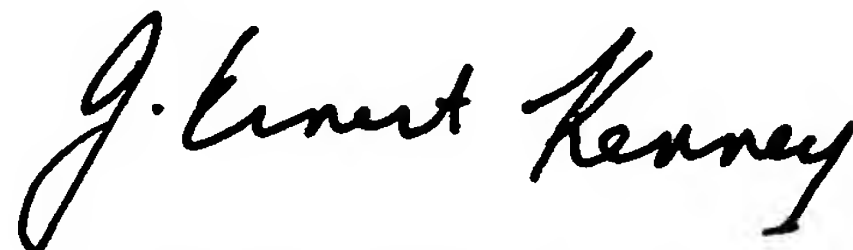
In view of the amendments to the claims, and in further view of the foregoing remarks, it is respectfully submitted that the application is in condition for allowance. Accordingly, it is requested that claims 1-5, 7, and 8 be allowed and the application be passed to issue.

If any issues remain that may be resolved by a telephone or facsimile communication with the Applicant's attorney, the Examiner is invited to contact the undersigned at the numbers shown.

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Respectfully submitted,



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